



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,353	09/23/2003	Michael J. Cleary	JPC-010	3390
70813	7590	12/22/2011		
GOODWIN PROCTER LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001			EXAMINER SHRESTHA, BLENDRA K	
			ART UNIT 3691	PAPER NUMBER
			NOTIFICATION DATE 12/22/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AAAlpha-Kpetewama@goodwinprocter.com

patentdc@goodwinprocter.com

fmcneon@goodwinprocter.com

Office Action Summary**Application No.**

10/667,353

Applicant(s)

CLEARY ET AL.

Examiner

BIJENDRA K. SHRESTHA

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-36 and 41 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-36 and 41 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

Claims 1-36 and 41 are presented for examination. Applicant filed an amendment 08/31/2011 amending claims 1, 17 and 27. After careful consideration of applicant's arguments and amendments, new grounds of rejections of claims have been established in the instant application as set forth in detail below. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-36 and 41 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 17 and 27 recite "the dead bank card and the inactive deposit account being unsolicited" but the written description only supports "unsolicited dead bank card". The applicant is requested to cite a portion of written description where such reference is made in response to this office action. The recited claims are examined as presented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 1-22, 24-26 and 41 are rejected under 35 U.S.C. 103 (a) as being unpatentable by Melchione et al. U.S. Patent No. 5,930,764 (reference A in attached PTO-892) in view of Walker et al., U.S. Pub No. 2008/0052225 (reference B in attached PTO-892) further in view of Richards, B., Madison Capital Times, 2000 (reference U in attached PTO892) and BankersOnline.com (reference V in attached PTO-892) in view of Jones et al., U.S. Pub No. 2004/0117300 (reference C in attached PTO892) and Nabe et al., U.S. Patent No.7,305,364 (reference D in attached PTO-892).*
5. As per claims 1, 15 and 16, Melchione et al. teach a method for distributing bank cards, comprising:

Identifying, by at least a processor, a pool of potential new bank account holders for a bank (see Fig. 1; column 1, line 29; column 27, lines 32-43; 41-48; where customer Leads from Micro-marketing Center (11) fed to Central Database (10) which ultimately led to Business Feed (22) which include different services provided by the bank such as shown Fig. 13A and where workstation at Micro-marketing center provides means for

searching the central database and extract accounts that meets specific selection criteria);

determining, by said at least one processor, if a person from the pool is an existing bank *deposit* account holder (see Fig. 1, column 3, lines 4-13; column 18, lines 49-60; Fig. 10 A and 10 B; column 44, lines 10-14; where workstation at Micro-marketing center provides means for searching the central database using Query language and extract a list of all households, customers that meets specific selection criteria using and sales leads from Micro-marketing Center segregated into new customer and existing customer based on information entered to identify customer and the sales campaign (Fig. 8C));

determining whether the person is eligible for opening a new bank *deposit* account *comprising a checking account or a saving account* if the person is not an existing bank account holder (see Fig. 6B; Fig. 10B, Needs Assessment (500), Credit Check; column 48, lines 61-67 to column 49, lines 1-8, 60-67 to column 50, lines 1-2);

creating a bank card including embossed information and magnetic stripe information specific to the person (see Fig. 16D; column 55, lines 34-43).

Melchione et al. do not teach the dead bank card and inactive deposit account being unsolicited.

Richards and Bankers Online.com both teaches issuing preapproved unsolicited debit cards to customers which need to be accepted and activated by the customers to its deposit account(see page 1, abstract (Richards, first line second paragraph; Full Text, page 1, paragraph 1-9; Bankers Online.com, page 9, 5(b)

Unsolicited Issuance; where unsolicited bank card is inactive until consumer accepts and financial institution validates the access device to its ATM).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the dead bank card and inactive deposit account being unsolicited of Melchione et al. because Richard teaches including above features would provide convenience and say "Good-Bye Hassles" by activating the card by calling an 800 toll free number (Richard, B., Page 1; Abstract. first sentence second paragraph; Full Text, second paragraph).

Melchione et al. do not teach a dead bank card associated with an inactive bank account, and distributing the dead bank card from the issuing bank to the person.

Walker et al. teach a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person (Walker et al., abstract; Fig. 5A-5C, steps 560-575, paragraph [0050-0051]; where dead bank card or inactive card unsolicited by a customer transmitted to sponsoring organization (step 560) and offered to customer upon arrival at sponsoring organization, such as hotel (step 570); the credit account is inactive, account is activated only after accepted by the customer (Step 575 - 585), credit card is destroyed if the consumer declines the offer (step 575 - 580)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person of Melchione et al. because Walker et al. teach including above features enables to encourage consumer to utilize

new credit card (dead card) by instantly issuing and activating a new card as part of a chargeable event (Walker et al., paragraph [0011]).

Melchione et al. do not teach issuing dead bank card associated with deposit account.

Jones et al. teach issuing debit card to customers (Jones et al., Fig. 1; paragraph [0023], [0050], [0055] and [0059]; where debit card (in addition to existing credit card making dual card being issued to qualified customer which need to activated by the customer).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include issuing dead bank card associated with deposit account of Melchione et al. because Jones et al. teach including above features enables to deduct the expense the existing deposit in the bank instead of credit to customer account.

Melchione et al. do not teach selling (or issuing credit card) to inactive customer.

Nabe et al. teach selling to inactive customer base (see Fig. 4, Inactive auto Finance Customer Base (120)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include selling to inactive customer base of Melchione et al. because Nabe et al. teach including above features enables one or more inactive customer respond to offer to sell (Nabe et al., column 1, lines 34-35).

6. As per claim 2, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

Melchione et al. do not teach the pool is identified based on the region or regions served by the bank issuing the new bank accounts.

Walker et al. teach the pool is identified based on the region or regions served by the bank issuing the new bank accounts (see (Walker et al., paragraph [0032]; where potential new account are identified through the routine hotel reservation process served by the issuing bank).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the pool is identified based on the region or regions served by the bank issuing the new bank accounts of Melchione et al. because Walker et al. teach including above features enables to activate the issued credit card by the customer immediately at checking by providing some incentive/benefits (Walker et al., paragraph [0032]).

7. As per claim 3, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the pool is identified based on individuals applying for new credit account (see Fig. 10 B; column 27, lines 39-48; column 27, lines 28-58).

8. As per claim 4-8, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the pool is identified based on a life event comprising a move to a new residence, a marriage or divorce, a death of a partner or spouse, a birth or a new phone account (see Fig. 6C, Display Customer Needs and Notes Screen; column 1, lines 38-52; column 35, lines 51-57).

9. As per claim 9, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method including

determining whether the person was a previous bank account holder (see Fig. 10A/10B; Needs Assessment; column 44, lines 10-21; 48-67; column 48, lines 59-67); where Greeter identify new customer by reviewing the profile to prepare for session).

10. As per claim 10, Melchione et al. teach claim 9 as described above. Melchione et al. further teach the method including

determining why the person closed the previous bank account in the event the person was a previous bank account holder (see Fig. 10A; steps 200-700; Fig. 10B, Update Personal Profile (700), Credit Check: column 44, lines 10-26; where system distinguishes new customer and existing (or past) customer during the session and required information is received and processed accordingly).

11. As per claim 11, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the step of determining whether the person is eligible comprises evaluating credit score information supplied by a credit bureau (see 12 B-C; column 49, lines 53-67).

12. As per claim 12, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein the step of determining whether the person is eligible comprises

determining whether the person is an existing or past credit card account holder with the bank and evaluating the payment history if the person is an existing or past credit account holder (see Fig. 6C; column 34, lines 20-40; column 35, lines 19-45;

where SQL Query provides information about the person and relationship profile component provides current and historical financial and behavioral relationship of the customer with the bank which aids in providing better sales preparation tools).

13. As per claim 13, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method wherein

the step of determining whether the person is eligible comprises evaluating the age of the person (see Fig. 12; column 49, lines 17-25; where preliminary profile include collection of social security number and date of birth).

14. As per claim 14, Melchione et al. teach claim 1 as described above. Melchione et al. further teach the method comprising

the step of prebuilding an account if the person is determined to be eligible, thereby permitting the bank to implement the new bank account quickly upon acceptance of the offer by the person (see Fig. 10A/10B; column 49, lines 1-67 to column 50, lines 1-67; where account is prebuilt based on need assessment prior to making an offer).

15. As per claim 17, Melchione et al. teach a method of distributing bank cards, comprising:

receiving a customer application for a credit card to be issued by a bank (see Fig. 10A/10B; Fig. 13A; column 45, lines 1-9; where greeter identifies customer needs and receives information from credit card applicant);

processing the application to determine a decision on the credit card (see Fig. 13 A, H, K-M; Column 53, lines 7-20; column 54, lines 6-17);

determining whether the customer is an existing bank account holder of the bank (see Fig. 1, column 3, lines 4-13; column 18, lines 49-60; Fig. 10 A and 10 B; column 44, lines 10-14; where workstation at Micro-marketing center provides means for searching the central database using Query language and extract a list of all households, customers that meets specific selection criteria using and sales leads from Micro-marketing Center segregated into new customer and existing customer based on information entered to identify customer and the sales campaign (Fig. 8C));

distributing a live credit card to the customer if the application is approved and the customer is an existing bank account holder (see Fig. 10A and 10 B; column 53, lines 22-42; where secured and unsecured credit card can be issued to existing and new account holder);

delivering a bank card including embossed information and magnetic stripe information specific to the person (see Fig. 16D; column 55, lines 34-43);

Melchione et al. do not teach distributing *an unsolicited* dead bank card associated with an *inactive bank account* to the customer if the application is approved and the customer is not an existing bank account holder.

Walker et al. teach distributing *an unsolicited* dead bank card associated with an inactive bank account to the customer if the application is approved and the customer is not an existing bank account holder (Walker et al., abstract; Fig. 5A-5C, steps 560-575, paragraph [0050-0051]; where dead bank card or inactive card unsolicited by a customer transmitted to sponsoring organization (step 560) and offered to customer upon arrival at sponsoring organization, such as hotel (step 570); the credit account is

inactive, account is activated only after accepted by the customer (Step 575 - 585), credit card is destroyed if the consumer declines the offer (step 575 – 580)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include distributing *an unsolicited* dead bank card associated with an inactive bank account to the customer if the application is approved and the customer is not an existing bank account holder of Melchione et al. because Walker et al. teach including above features enables to encourage consumer to utilize new credit card (dead card) by instantly issuing and activating a new card as part of a chargeable event (Walker et al., paragraph [0011]).

Melchione et al. do not teach the dead bank card and inactive deposit account being unsolicited.

Richards and **Bankers Online.com** both teaches issuing preapproved unsolicited debit cards to customers which need to be accepted and activated by the customers to its deposit account(see page 1, abstract (Richards, first line second paragraph; Full Text, page 1, paragraph 1-9; Bankers Online.com, page 9, 5(b) Unsolicited Issuance; where unsolicited bank card is inactive until consumer accepts and financial institution validates the access device to its ATM).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the dead bank card and inactive deposit account being unsolicited of Melchione et al. because Richard teaches including above features would provide convenience and say "Good-Bye Hassles" by activating the card by calling an

800 toll free number (Richard, B., Page 1; Abstract. first sentence second paragraph; Full Text, second paragraph).

Melchione et al. do not teach issuing dead bank card associated with deposit account.

Jones et al. teach issuing debit card to customers (Jones et al., Fig. 1; paragraph [0023], [0050], [0055] and [0059]; where debit card (in addition to existing credit card making dual card being issued to qualified customer which need to activated by the customer).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include issuing dead bank card associated with deposit account of Melchione et al. because Jones et al. teach including above features enables to deduct the expense the existing deposit in the bank instead of credit to customer account.

Melchione et al. do not teach selling (or issuing credit card) to inactive customer base.

Nabe et al. teach selling to inactive customer base (see Fig. 4, Inactive auto Finance Customer Base (120)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include selling to inactive customer base of Melchione et al. because Nabe et al. teach including above features enables one or more inactive customer respond to offer to sell (Nabe et al., column 1, lines 34-35).

16. As per claim 18, Melchione et al. in view of Walker et al. teach claim 17 as described above. Melchione et al. further teach the method comprising

the step of determining if the customer is eligible to be a bank account holder of the bank (see Fig. 6B).

17. As per claim 19, Melchione et al. in view of Walker et al. teach claim 18 as described above. Melchione et al. further teach the method wherein

the step of determining if the customer is eligible comprises determining whether the customer resides within the bank account service footprint of the bank (see Fig. 6C; column 35; lines 49-67 to column 36, lines 1-22; where customer demographic information, bank service usage pattern and branch where the customer account is domiciled determines whether the customer resides within the bank account service footprint of the bank).

18. As per claim 20, Melchione et al. in view of Walker et al. teach claim 18 as described above. Melchione et al. further teach the method wherein

the step of determining if the customer is eligible comprises performing a credit check or risk analysis supplemental to that performed for the credit card application (see Fig. 11C; Fig. 12B-C; column 49, lines 35-59).

19. As per claim 21, Melchione et al. in view of Walker et al. teach claim 17 as described above. Melchione et al. further teach the method comprising

the step of determining whether the customer is a past bank account holder of the bank ((see Fig. 10A/10B; Needs Assessment; Credit Check: column 44, lines 10-21;

48-67; column 48, lines 59-67); where Greeter identify past customer by reviewing the profile to prepare for session).

20. As per claim 22, Melchione et al. in view of Walker et al. teach claim 21 as described above. Melchione et al. further teach the method comprising

determining the reason the past bank account was closed and evaluating the reason prior to the decision to distribute a dead bank card to the customer (see Fig. 10A/B; column 34, lines 20-39; where relationship profile component provides historical financial and behavioral information of the customer with the bank which examiner interprets include reason the past bank account was closed).

21. As per claim 24 -25, Melchione et al. in view of Walker et al. teach claim 17 as described above. Melchione et al. further teach the method wherein

the live credit card and dead bank card are communicated to the customer in a single mailing or different mailings (see Fig. 16A, Issue CITICARDS; where bank issues different credit cards (secured and unsecured), mailing of which can be of together or separately).

22. As per claim 26, Melchione et al. in view of Walker et al. teach claim 17 as described above.

Melchione et al. do not teach prebuilding a new bank account for the customer prior to distributing the dead bank card.

Walker et al. teach prebuilding a new bank account for the customer prior to distributing the dead bank card (see Fig. 5A/5B).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include prebuilding a new bank account for the customer prior to distributing the dead bank card of Melchione et al. because Walker et al. teach including above features enables credit card issuer to instantly issue new credit card to credit qualified new customers (Walker et al., paragraph [0011]).

23. As per claim 41, Melchione et al. in view of Walker et al. teach claim 1 as described above.

Melchione et al. do not teach the method of distributing card comprises the recipient of the dead bank card opening the inactive account.

Walker et al. teach recipient of the dead bank card opening the inactive account (see Fig. 5C, paragraph [0050 - 0051]; where inactive account for a customer is established by a sponsoring organization such as hotel, which is activated only after the customer acceptance).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the method of distributing card comprises the recipient of the dead bank card opening the inactive account of Melchione et al. because Walker et al. teach including above features enables encourage consumer to utilize new credit card (dead card) by instantly issuing and activating a new card as part of a chargeable event (Walker et al., paragraph [0011]).

24. *Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al. U.S. Patent No. 5,930,764 (reference A in attached PTO-892) in view of Walker et al., U.S. Pub No. 2008/0052225 (reference B in attached PTO-892) further*

in view of Richards, B., Madison Capital Times, 2000 (reference U in attached PTO892) and BankersOnline.com (reference V in attached PTO-892) and in view of Jones et al., U.S. Pub No. 2004/0117300 (reference C in attached PTO892) and Nabe et al., U.S. Patent No.7,305,364 (reference D in attached PTO-892) further in view of Strock et al., U.S. Pub No. 2004/0122736 (reference E in attached PTO-892).

25. As per claim 23, Melchione et al. in view of Walker et al. teach claim 21 as described above.

Melchione et al. do not teach the method comprising the step of providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers.

Strock et al. teach the method comprising the step of providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers (Strock et al., Fig. 3B; abstract, Fig. 3, Create Reward Account population Module (44), paragraph [0064-0065]; where promotional reward or incentive is targeted to specific

bank or credit card members or group who may or may not be].

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include providing an incentive to a customer who is not an existing bank account holder, a first incentive being provided to a customer who is not an existing bank account holder and who is not a past bank account holder, and a second incentive being provided to a customer who is not an existing bank account holder and who is a past bank account holder, thereby providing different incentives to new bank account customers and past bank account customers of Melchione et al. because Strock et al. teach including above features *enables define population eligible to participate in particular reward program* (Strock et al., paragraph [0064]).

26. *Claims 27-32 are rejected under 35 U.S.C. 103(a) as being anticipated by Jones et al. U.S. Pub No. 2004/0117300 (reference C in attached PTO-892) in view of Walker et al., U.S. Pub No. 2008/0052225 (reference B in attached PTO-892) further in view of Richards, B., Madison Capital Times, 2000 (reference U in attached PTO892) and BankersOnline.com (reference V in attached PTO-892) and Nabe et al., U.S. Patent No. 7,305,364 (reference D in attached PTO-892).*

27. As per claim 27, Jones et al. teach a method of distributing solicited credit cards and unsolicited bank cards, comprising:

receiving from a customer an application for a credit card to be issued by a bank (see Fig. 2A);

processing the application (see Fig. 2B);

determining if the customer is an existing bank account holder with the bank (see Fig. 5A, step 206);

distributing a live credit card to the customer if the application is approved and the customer is already an existing bank *deposit* account holder (see Fig. 2B); and

distributing a live credit card to the customer if the application is approved and the customer is not an existing bank account holder (see Fig. 5A, step 206; where live card is issued to new customer subject to the customer activation in step 254 (Fig. 5B)).

distributing an dead bank card associated with an inactive deposit account *comprising a checking account or a savings account from the issuing bank* to the customer (see Fig. 1; paragraph [0023], [0050], [0055] and [0059]; where debit card (in addition to existing credit card making dual card being issued to qualified customer which need to activated by the customer).

Jones et al. do not teach distributing *an unsolicited* dead bank card associated with an inactive *bank account* to the customer if the application is approved and the customer is not an existing bank *deposit* account holder and processing a customer response to the dead bank card.

Walker et al. teach distributing *an unsolicited* dead bank card to the customer if the application is approved and the customer is not an existing *bank account* holder and processing a customer response to the dead bank card (Walker et al., abstract; Fig. 5A-5C, steps 560-575, paragraph [0050-0051]; where dead bank card or inactive card unsolicited by a customer transmitted to sponsoring organization (step 560) and offered

to customer upon arrival at sponsoring organization, such as hotel (step 570); the credit account is inactive, account is activated only after accepted by the customer (Step 575 - 585), credit card is destroyed if the consumer declines the offer (step 575 – 580)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include distributing *an unsolicited* dead bank card to the customer if the application is approved and the customer is not an existing *bank account* holder and processing a customer response to the dead bank card of Jones et al. because Walker et al. teach including above features enables credit card issuer to instantly issue new credit card to credit qualified new customers and receive the credit card activation from the new customer as a part of a chargeable event (Walker et al., paragraph [0011]).

Melchione et al. do not teach the dead bank card and inactive deposit account being unsolicited.

Richards and **Bankers Online.com** both teaches issuing preapproved unsolicited debit cards to customers which need to be accepted and activated by the customers to its deposit account(see page 1, abstract (Richards, first line second paragraph; Full Text, page 1, paragraph 1-9; Bankers Online.com, page 9, 5(b) Unsolicited Issuance; where unsolicited bank card is inactive until consumer accepts and financial institution validates the access device to its ATM).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the dead bank card and inactive deposit account being

unsolicited of Melchione et al. because Richard teaches including above features would provide convenience and say "Good-Bye Hassles" by activating the card by calling an 800 toll free number (Richard, B., Page 1; Abstract. first sentence second paragraph; Full Text, second paragraph).

Melchione et al. do not teach selling (or issuing credit card) to inactive customer base.

Nabe et al. teach selling to inactive customer base (see Fig. 4, Inactive auto Finance Customer Base (120)).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include selling to inactive customer base of Melchione et al. because Nabe et al. teach including above features enables one or more inactive customer respond to offer to sell (Nabe et al., column 1, lines 34-35).

28. As per claim 28, Jones et al. in view of Walker et al. teach claim 27 as described above. Jones et al. further teach the method wherein

the customer response accepts the new bank account associated with the dead bank card, and wherein the processing comprises funding the new bank account (see Fig. 5A; Fig. 5C, step 272 and 274).

29. As per claim 29, Jones et al. in view of Walker et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is from a customer-supplied source of funds (Fig. 5c, step 274; paragraph [0091]).

30. As per claim 30, Jones et al. in view of Walker et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is from the credit account associated with the live credit card distributed with the dead bank card (Fig. 5c, step 274; paragraph [0091]).

31. As per claim 31, Jones et al. in view of Walker et al. teach claim 28 as described above. Jones et al. further teach the method wherein

the funding is an incentive deposit provided by the bank to incentivize the customer to accept the new bank account (see Fig. 5C, steps 282-290; paragraph [0088]), [0095]).

32. As per claim 32, Jones et al. in view of Walker et al. teach claim 27 as described above. Jones et al. further teach the method wherein

the credit card and the bank card are linked through a reward or rebate program (see paragraph [0090], [0091]).

33. *Claim 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. U.S. Pub No. 2004/0117300 (reference C in attached PTO-892) in view of Walker et al., U.S. Pub No. 2008/0052225 (reference B in attached PTO-892) further in view of Richards, B., Madison Capital Times, 2000 (reference U in attached PTO892) and BankersOnline.com (reference V in attached PTO-892) and Nabe et al., U.S. Patent No.7,305,364 (reference D in attached PTO-892) and Strock et al., U.S. Pub No. 2004/0122736 (reference E in attached PTO-892).*

34. As per claim 33-34 and 36, Jones et al. teach claim 27 as described above.

Jones et al. do not teach offering reward or rebated based on credit card usage.

Strock et al. teach offering reward or rebated based on credit card usage (Strock et al., paragraph [0010]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include offering reward or rebated based on credit card usage of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

35. As per claim 35, Jones et al. teach claim 33 as described above. Jones et al. further teach the method, wherein

offering different levels of incentive to the customer to use the credit card and the bank card (see paragraph [0095] and [0096]).

Jones et al. do not teach the first rewards or rebates and the second rewards or rebates are different.

Strock et al. teach the first rewards or rebates and the second rewards or rebates are different (Strock et al., Fig. 3B; paragraph [0002]; where promotional reward or incentive is targeted to specific bank or credit card members or group).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include first rewards or rebates and the second rewards or rebates are different of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship

between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

36. As per claim 36, Jones et al. teach claim 27 as described above.

Jones et al. further teach the method, wherein the bank provides the customer an incentive deposit of rewards or rebates to accept the new bank account associated with the dead bank card (see paragraph [0095] and [0096]).

Jones et al. do not teach the credit card is a cobranded credit card offering first rewards or rebates based on credit card usage.

Strock et al. teach the credit card is a cobranded credit card offering first rewards or rebates based on credit card usage (Strock et al., paragraph [0010]).

Therefore, it would be prima facie obvious to one of ordinary skill in the art at the time the invention was made to include offering first rewards or rebates based on credit card usage of Jones et al. because Strock et al. teach including above features enables to encourage certain customer behavior, strengthen relationship between bank and customers, and attract and retain loyal customers (Strock et al., paragraph [0003] and [0004]).

Response to Arguments

37. After careful consideration of applicant's arguments and amendments, new ground of rejections of claims necessitated by the applicant amendment has been established in the instant application. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Nonobviousness cannot be established by attacking the references individually, when the rejection is predicated upon a combination of prior art disclosures. See *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir.1986).The applicant has attacked the references individually, when rejection was made using a combination of teachings of multiple references. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Examiner rejection is based teachings of combination of references such as creating bank card including embossed information and magnetic stripe information after identifying a pool of potential new bank account holders for a bank (*Melchione et al.*, Fig. 16A; column 55, lines 34-43); issuing preapproved *unsolicited* debit cards to customers which need to be accepted and activated by the customers, and approved by the bank (see page 1, abstract (*Richards*, first line second paragraph; Full Text, page 1, paragraph 1-9; *Bankers Online.com*, page 9, 5(b) Unsolicited Issuance); a dead bank card associated with an inactive bank account, and distributing the dead bank card to the person (*Walker et al.*, abstract; Fig. 5A-5C, steps 560-575, paragraph [0050-0051]);

issuing debit card to customers (*Jones et al.*, Fig. 1; paragraph [0023], [0050], [0055] and [0059]; where debit card (in addition to existing credit card making dual card being issued to qualified customer which need to activated by the customer); selling (or issuing credit card) to inactive customer base (*Nabe et al.*, Fig. 4, Inactive auto Finance Customer Base (120)); and offering reward or rebated based on credit card usage (*Strock et al.*, paragraph [0010]).

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention (Rationale A). Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Boyd and Ovadia into the disclosure of Pentel and the results would have been predictable to one of ordinary skill in the art (Rationale D).

Melchione specifically teaches using Structured Query Language (SQL) to locate specific record in the central database and generating list of lead that used for target customers for specific marketing campaign (Melchione, column 3, lines 4-13; column 4, lines 54-57; column 8, lines 59-67 to column 9, lines 1-11; column 18, lines 49-59). The reference of Richard identifies risk directly linking unsolicited debit card to deposit

account after calling attached toll free number by the customer. A person of ordinary skill of art easily can conclude from the reference that unsolicited debit card should not be directly linked to active deposit account. The Bankersonline.com requires ATM system be programmed not to accept the unsolicited debit card after consumer requests and financial institution validates the debit card (Bankersonline.com, page 5, 5 (b) /Compliance paragraph). If Richard and Bankersonline.com teaches unsolicited debit card and Walker et al. teaches unsolicited credit card, The dual card taught by Jones can be considered to be issued unsolicited.

The applicant argument that "Nabe is only is directed to loan accounts, not deposit account, and does not teach or suggest distribution or dead card...unsolicited dead bank card..." is not agreeable as these limitation are taught by other references cited. Nabe teaching is only used for "selling to inactive customer base" with reference to limitation of instant application "opening a new bank account if customer is not existing bank account holder".

Applicant should note that debit or credit card solicited or unsolicited are issued by financial institution in Melchione, Richards, Bankeronline.com but applicant argued that it is issued by "sponsoring organization" in Walker which examiner interprets could be a financial institution.

As per claim 2 and 19, Melchione teaches customer demographic information, bank service usage pattern and branch where the customer account is domiciled determines whether the customer resides within the bank account service footprint of the bank. Further, the branch manager receives local leads generated by

micromarketing center and loads leads into CCIS to distribute among selected personal bankers within the community banks (Melchione, column 9, lines 30-67).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

38. Accordingly, this action is made **Non-Final**. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Buchanan et al. (U.S. Patent No. 5,950,179) teach method and system for issuing a secured credit card product.

Christiansen et al. (U.S. Patent No. 6,202,053) teach method and apparatus for generating segmentation scorecards for evaluating credit risk of bank card applicants.

Hall, III et al. (U.S. Patent No. 6,158,657) teach system and method for offering and providing secured.

Kishen et al. (U.S. Pub No. 2004/0103065) teach systems and method for soliciting customers using computer readable media.

Matada (U.S. Patent No. 6,817,521) teaches credit application automation system.

Mobed et al. (U.S. Patent No. 7,103,573) teach user rewards program and communication system.

Nabe et al. (U.S. Pub No. 2002/0194050) teaches methods and systems for supplying customer leads to dealers.

Rubio et al. (U.S. Pub No. 2002/0062241) teach apparatus and method for coding electronic direct marketing lists to common searchable format.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 8:00AM-4:30 PM(Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 3691

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BIJENDRA K. SHRESTHA/
Primary Examiner, Art Unit 3691
12/18/2011